

REMARKS

This paper constitutes the required submission corresponding to a Request for Continued Prosecution (RCE) of the subject application that accompanies this paper. Claims 1-26 are pending in the subject application, including independent Claims 1, 13, 22 and 23. Claims 1-6 and 8-26 stand finally rejected in the Final Office Action issued September 23, 2004, and Claim 7 stands allowable but objected to.

Amendment

Each of the independent claims that presently stand rejected, including Claims 1, 13, 22 and 23, is amended herein in a similar manner. Each of these claims is amended to clarify the meaning and operation of a "reverse link handoff" or "reverse link intergenerational hard handoff," as appropriate for the particular claim. It is respectfully submitted that the present claim amendments merely explicitly state the definitions that would be determined to be conveyed by a proper construction of the terms as set forth in the original claims. Therefore, it is submitted that the present claim amendments are not narrowing. It is understood that the Examiner does not agree that the claims, as previously presented, conveyed the meaning that is now stated explicitly. Therefore, the Examiner does not need not restate that point. Indeed, it is respectfully submitted that this difference of opinion about the meaning conveyed by the original language of the claims is responsible for the previous failure to achieve progress toward allowance of all of the claims. The present amendment should lay this difference to rest.

No new matter is added by the present amendment. Support for the amendments may be found throughout Applicants' specification. The following examples support aspects of the amendments. An intergenerational handoff is a handoff between base stations of different generations (p. 6 line 14 *et seq.*). A "complete" handoff includes a forward link handoff and a reverse link handoff (p. 6 lines 27-29). Forward link and reverse link handoffs are distinct, having characteristics that are substantially independent of each other. For example, the forward link handoffs of a particular complete handoff (e.g. an intergenerational handoff "IGHO," see p. 11 lines 8-16) may be soft or hard, irrespective of the reverse link handoff being hard. Moreover, forward-

and reverse-link handoffs affect oppositely-directed signals, with forward link handoffs controlling reception by a mobile station (MS) of signals from base stations, while reverse link handoffs control transmissions from an MS to base stations (BSs). In particular, reverse link handoffs include terminating (severing) transmissions from an MS to a serving BS, and initiating transmissions from the MS to a target BS (see p. 18 lines 5-7).

Response to Final Rejection

In the Office Action issued September 23, 2004 ("the Final Rejection") that finally rejected the subject application, the Examiner reiterated an earlier double patenting rejection. Applicants respectfully request to hold this matter in abeyance pending determination of allowable claims, at which time a terminal disclaimer will be executed if deemed necessary.

In the Final Rejection, the Examiner disputes Applicants' characterization of previous amendments as non-narrowing. With all due respect, determination of whether an amendment is "narrowing" or not depends upon a construction of the claim prior to and after entry of the amendment, which is a matter of law to be determined by a court. Applicants' characterization is provided as part of an explanation for amendments that is made advisable by the various Supreme Court opinions relating to the well-known *Festo* litigation. Rather than dispute with the Examiner that a particular term, such as "reverse link handoff" conveys a particular meaning when considered in view of Applicants' specification, Applicants may agree to amend the claims to resolve the dispute to the satisfaction of the Examiner. However, to the extent that a court later considering a resulting patent or allowed claims agrees that the claims, as originally filed, already conveyed the meaning expressed by such amendment, a penalizing loss of "doctrine of equivalents" claim scope may be avoided. However, an explanation of the reason for such amendment may be required to be clear in the prosecution record in order to avoid the penalty. It is respectfully submitted that such characterization has no bearing on whether or not the claims, as amended, are properly allowable.

Stated differently, an Applicant's assertion that a particular amendment is non-narrowing typically serves primarily to reserve, for later litigation, the question of whether the claim in question already implicitly required the limitations that were set forth explicitly by the amendment.

It is respectfully submitted that the present amendments are, in fact, non-narrowing, because they merely make explicit that which was implicit in the corresponding claim prior to the amendment, when such prior corresponding claim is properly construed in view of Applicants' specification. It is understood that the Examiner does not agree that the term "reverse link handoff" conveyed such meaning. Therefore, the Examiner need not restate that position. The Examiner's contrary opinion is conveyed, for example, by the last full paragraph of page 4, and again by the last full paragraph of page 6, of the Final Rejection. However, irrespective of whether or not the claims, as previously amended, conveyed the meaning that is required by the claims as presently amended, it is respectfully submitted that the claims, as presently amended, overcome all present grounds of rejection (aside from double patenting, which is held in abeyance).

In section 10 of the Final Rejection, the Examiner rejects Claim 22 as obvious over Czaja '666 in view of Ramakrishna. Ramakrishna does not disclose reverse link handoffs, nor does the Examiner cite Ramakrishna for this element. The Examiner cites Czaja '666 for the element of (a fourth set of instructions for) "initiating a reverse link handoff between the serving and target base stations if the first parameter is less than or equal to the second parameter." To support the assertion that Czaja '666 discloses this element, the Examiner states (page 12 of the Final Rejection, first full paragraph) "Since the handoff [described in Czaja] is initiated by the mobile unit from the reverse link and performed by BS between intergeneration systems, it is a reverse link hard handoff."

At least in view of the present amendments, the Examiner will see that this supporting statement is not correct for a reverse link hard handoff as required by Claim 22 as presently amended. That is, a reverse link hard handoff is required, by Claim 22 as presently amended, to include "terminating signal transmissions from the mobile station to the serving base station and subsequently initiating signal transmission from the mobile station to the target base station." This is not discussed in Czaja '666 in the context of initiating such handoff on any basis, let alone on the basis of a comparison of parameters. Thus, at least for this reason, the combination of Czaja '666 and Ramakrishna fails to disclose all of the elements of Claim 22 as presently amended. As such, this combination of references fails to support a *prima facie* case of obviousness for Claim 22 as presently amended.

In section 11 of the Final Rejection, the Examiner rejects Claims 1-6, 8, 13-17, and 23-26 as obvious over Czaja '666 in view of Ramakrishna, and further in view of Tiedemann. This grounds of rejection is unwarranted for the same-numbered claims, as presently amended. As noted in the remarks set forth above with respect to a similar element in Claim 22, Ramakrishna does not disclose, and is not cited for, "initiating a reverse link portion of the directed handoff between the serving and target base stations if the first parameter is less than or equal to" Tiedemann also fails to disclose or suggest this element. For the same reasons as set forth above with respect to Claim 22, Czaja '666 also fails to disclose this element, at least in view of the requirement of presently amended Claim 1, that "the reverse link portion of the handoff includes terminating transmissions from the subject mobile station to the serving base station, and initiating transmission from the subject mobile station to the target base station." Accordingly, the cited combination fails to disclose or fairly suggest all of the elements of, *e.g.*, Claim 1 as presently amended, and thus does not support a *prima facie* case of obviousness of Claim 1.

The reasoning set forth above with respect to Claim 1 applies equally to Claims 13 and 23, such that none of the independent claims, as presently amended, is rendered obvious by a combination of Czaja '666, Ramakrishna, and Tiedemann. As the Examiner presents no further reference as disclosing the element quoted above, and in view of the remarks set forth above, it is respectfully submitted that each of the independent claims as presently amended is nonobvious and properly allowable over each combination of references that has been cited by the Examiner.

Other reasons supporting the allowability of the claims of the subject application, as previously amended, have been set forth in previous papers submitted on behalf of the Applicants. Such other reasons are of record and are not rendered less valid by the present amendment. Such previously presented reasons, together with any other reasons that have not been set forth in a previous paper, are expressly reserved to be presented if needed. However, because the grounds of rejection that was previously set forth is believed to be unwarranted for the claims as presently amended, such other reasons for allowability are presently omitted for brevity.

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Conclusion

In view of the foregoing remarks and amendments, it is respectfully submitted that each claim, as presently pending in the subject application, is in condition for immediate allowance. As such, the Examiner is respectfully requested to withdraw each of his grounds for rejection, and to promptly issue a Notice of Allowance in respect of all pending claims.

The Commissioner is authorized to construe this paper as including a petition to extend the period for response by the number of months necessary to make this paper timely filed. Fees or deficiencies required to cause the response to be complete and timely filed may be charged, and any overpayments should be credited, to our Deposit Account No. **50-0490**.

Respectfully submitted,

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